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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,557	06/19/2006	Kenichi Motoyama	292358US0PCT	9829
22850 7590 12/17/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER LOEWE, ROBERT S	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 12/17/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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**ATTACHMENT SHEET TO ADVISORY ACTION**

***Response to Arguments***

Applicant's arguments regarding the 103(a) rejection of Nogami et al. in view of Crompton for claims 1-15 have been fully considered and are persuasive. Therefore this rejection has been withdrawn.

Applicant's arguments regarding the 103(a) rejection of Nogami et al. in view of Hayashi et al. for claims 1-15 have been fully considered and are not found to be persuasive. Specifically, Applicant's argue that the references are not properly combinable because of the differences in the compositions and the manner in which the compositions are employed. Applicant's argue that the systems employed by Nogami et al. and Hayashi et al. are not the same and are used in different ways as a coating film.

However, both Nogami et al. and Hayashi et al. teach silica-based coating compositions which are prepared using sol-gel condensation of hydrolyzable silanes in the presence of silane adhesion promoters. It is believed by the Examiner that the differences between the compositions taught by Nogami et al. and Hayashi et al. do not preclude the combinability of these references. Applicants appear to be relying on bodily incorporation of the references to show the differences between them. However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Art Unit: 1796

Applicants further argue that Hayashi et al. does not teach or suggest that the two ureidosilanes taught therein are preferred, but rather they are merely listed in a list of 26 specific silane adhesion promoters. However, included in the 26 silane adhesion promoters is the aminosilane coupling agents taught by Nogami et al. Therefore, Hayashi et al. explicitly teaches that the aminosilane and ureidosilane coupling agents are functionally equivalent. Hayashi et al. does not need to show a preference for the ureidosilane coupling agent to make a case for functional equivalency.

Applicant's point to their working examples to show the improvement in the water-repellant, low refractive index films when ureidopropyltrimethoxysilane is employed as compared to using aminopropyltrimethoxysilane. While the data shown by Applicants in their instant specification may show a difference in the properties of the films when using ureidopropyltrimethoxysilane, such working examples do not clearly show unexpected results.

The data shown is semi-quantitative. Further, as an example, coating fluid 2, which is prepared according to Applicant's invention, does not appear to be substantially different than the comparative examples in its abrasion resistance. While this may or may not be attributed to the different curing temperature between coating fluid 2 and the comparative examples, the data presented in the instant specification is not sufficient to show that the aminopropyltrimethoxysilane and ureidopropyltrimethoxysilane are not functionally equivalent.

The prior art rejection of Nogami et al. in view of Hayashi et al. is maintained. Applicants can still overcome this rejection by a more detailed showing of unexpected results, commensurate in scope with the independent claims. The data presented in the instant

Art Unit: 1796

specification, taken as a whole, is deemed by the Examiner as insufficient to overcome the prior art rejection of Nogami et al. in view of Hayashi et al.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./  
Examiner, Art Unit 1796  
11-Dec-08

/Randy Gulakowski/

Application/Control Number: 10/583,557

Page 5

Art Unit: 1796

Supervisory Patent Examiner, Art Unit 1796